



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,669	11/08/2006	David B. Agus	67789-542	9540
50670	7590	04/15/2009	EXAMINER	
DAVIS WRIGHT TREMAINE LLP/Los Angeles 865 FIGUEROA STREET SUITE 2400 LOS ANGELES, CA 90017-2566			RAWLINGS, STEPHEN L	
		ART UNIT	PAPER NUMBER	
		1643		
		MAIL DATE	DELIVERY MODE	
		04/15/2009	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/568,669	AGUS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen L. Rawlings	1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 January 2009.

2a) This action is **FINAL**.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 10-19 and 29-33 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 10-19 and 29-33 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

1. The amendment filed January 5, 2009, is acknowledged and has been entered. Claims 1-9 and 29-28 have been canceled. Claims 10-12 have been amended. Claims 29-33 have been added.
2. Claims 1-19 and 29-33 are currently subject to the following requirement to elect and restrict.

### ***Election/Restrictions***

3. This application contains claims directed to the patentably distinct species of the elected invention.

Applicant has elected the invention of Group II, claims 10-19, drawn to a method of treating a condition in a mammal.

As amended, claims 10-19 are now generic and directed to a plurality of species of the elected invention, wherein said condition is a cancer selected from the group consisting of prostate cancer, breast cancer, lung cancer, ovarian cancer, brain cancer, colon cancer, and a combination of any of the preceding types of cancer.

M.P.E.P. § 808.01(a) states: "If applicant presents species claims to more than one patentably distinct species of the invention after an Office action on only generic claims, with no restriction requirement, the Office may require the applicant to elect a single species for examination". See M.P.E.P. §§ 811.02 and 818.02(b).

In this case, although it appears that each of the different species of invention may be linked by a common concept, or special technical feature, as set forth in the preceding Office action, Hedvat et al. (of record) teaches treating prostate cancer by administering to a mammal afflicted with the condition a quantity of R-etolodac and a quantity of a recombinant humanized antibody, which is designated 2C4; see entire document (e.g., the abstract). Accordingly, the technical feature that appears to link the inventive concepts of different species of the invention does not constitute a special

technical feature as defined by PCT Rule 13.1, as it does not define a contribution over the prior art.

In addition, it is noted that the species of the elected invention to which the generic claims are not directed are independent or distinct because the claims to these different species recite the mutually exclusive characteristics of such species, namely the different types of cancer or combinations of different types of cancer that are treated. Each different type of cancer is an etiologically and pathologically distinct disease.

Accordingly, at first glance, it appears that the claims directed to each different species of invention encompass subject matter that is distinct from the subject matter of the other species of invention. In addition, these species of the invention are not obvious variants of each other based on the current record.

4. Applicant is required under 35 U.S.C. 121 to elect a single claimed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

This election should be made by identifying the particular type of cancer or a particular combination of the different types of cancer to which the claims shall be restricted.

Currently, claims 10-19 are generic; claim 29 is directed in the alternative to the subject matter of the different species of the invention; and claims 30-33 are drawn to the species of the invention, wherein the condition (i.e., cancer) is prostate cancer.

Notably, there is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics, and particularly since each is or involves the use of a set of peptides that derived as fragments of structurally and/or functionally distinct proteins. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, first paragraph.

Furthermore, the Examiner notes that novelty and nonobviousness of the elected species of invention would render claims directed to that species allowable over the prior art, but not necessarily over the requirements set forth under 35 U.S.C. §§ 101 and 112.

5. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or *clearly* admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen L. Rawlings/  
Primary Examiner, Art Unit 1643

slr  
April 13, 2009